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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
KWON, BRIAN YONG S	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/056,284	WEISS ET AL.	
	Examiner	Art Unit	
	Brian S. Kwon	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *6-10* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,11-26,28 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. The rejection of the claims 1-2 and 18-20 under 35 U.S.C. 102(b) as being anticipated by Erikson et al. (WO 00/23060) is maintained for the reasons of record.

2. The rejection of the claim 27 under 35 U.S.C. 102(b) as being anticipated by Hammock et al. (WO 00/48593) is not maintained in light of the amendment.

3. The rejection of the claims 1-2 under 35 U.S.C. 102(e) as being anticipated by Ingraham et al. (US 2003/0022929 A1) is maintained for the reasons of record.

4. The rejection of the claims 11-17 and 22-26 under 35 U.S.C. 103(a) as being unpatentable over Ingraham et al. (US 2003/0022929 A1) in view of Selmon et al. (US 6120516) is maintained for the reasons of record.

5. The rejection of the claims 1-5 and 11-24 under the judicially created doctrine of double patenting over claims 1-2 of U. S. Patent No. 6693130 B2 or claims 1-9 of U.S. Patent No. 6531506 is not maintained in light of the amendment.

6. Applicant's amendment (requiring "does not have hypertension or is being treated for hypertension by an agent that is not an inhibitor of sHE ") necessitates a new ground of rejection(s) in this Office Action.

7. By Amendment filed March 25, 2005, claim 1 has been amended and claims 28 and 29 have been newly added. Claims 1-5, 11-26 and 28-29 are currently pending for prosecution on the merits.

Response to Amendment

8. The amendment filed March 25, 2005is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "and (ii) does not have hypertension or is being treated for hypertension by an agent that is not an inhibitor of sHE ".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-5, 11-25 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims in this application introduce a new limitation into the claim invention, namely "does not have hypertension or is being treated for hypertension by an agent that is not an inhibitor of sHE". The amendment requires that the treatment recipient group must meet two criteria to eligible for the instant method, one criteria (i) is selected from the group consisting of "has had a heart attack", "has had a coronary bypass", "has been diagnosed with decreased circulation to the heart", "has undergone angioplasty", "has an endovascular stent", "has a

hemodialysis graft" and "has a vascular graft" and the other criteria (ii) is selected from the group consisting of "does not have hypertension" and "is being treating for hypertension by an agent that is not an inhibitor of sHE". In other words, the instantly claimed subject or patient must have both conditions selected from each group (i) and (ii), for example subject who has had a heart attack, but does not have hypertension.

The specification discloses that as embodiments of the claim invention, the claimed method would benefit persons who has had a heart attack or are at risk of a heart attack (para. 12 and 46); has a coronary bypass (para. 12); has been diagnosed with decreased circulation to the heart (para. 12); has a undergone angioplasty (para. 12); has an endovascular stent (para. 41-44); has a hemodialysis graft (para. 13); has a vascular graft (para. 45); and does not have hypertension or is being treated for hypertension by an agent that is not an inhibitor of sHE (para. 47). As discussed above, the specification discloses that the administration of sHE is useful in treating persons who meet any one of above conditions. There is no express statement about the coexistence of the above mentioned group (i) and (ii) in the specification. Therefore, it would have been clear to one skilled in the art, reading the instant disclosure, that the claimed invention can be practiced with any one of condition selected from "has had a heart attack or are at risk of a heart attack", "has a coronary bypass", "has been diagnosed with decreased circulation to the heart", "has a undergone angioplasty", "has an endovascular stent", "has a hemodialysis graft", "has a vascular graft", "does not have hypertension" and "is being treated for hypertension by an agent that is not an inhibitor of sHE".

As discussed above, the inclusion of said elements implies the inclusion of other elements not expressly included, clearly illustrating that such limitation does, in fact, introduce new

matter. The limitation recited in the present claims, which did not appear in the specification filed, introduces new concepts and violate the description requirement of the first paragraph of 35 USC 112. Thus, the examiner determines that when all evidences in the original disclosure are considered and carefully reviewed, the newly amended claims fail to find support in the original specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 18-20 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Erikson et al. (WO 00/23060).

Erikson teaches the administration of epoxide hydrolase inhibitor (e.g., N-[4-(5-ethyl-3-pyridin-3-yl-pyrazol-1-yl)-phenyl]-nicotinamide, N-[4-(5-ethyl-3-pyridin-3-yl-pyrazol-1-yl)phenyl]-1-methylindole-2-carboxamide, etc...) to a subject for the treatment of immunological disorder (i.e., chronic and ischemic acute renal insufficiency, arteriosclerosis, atherosclerosis, interstitial nephritis, transplantation, graft versus host disease, etc...). See page 5, lines 1-25 and claims.

Although Erikson is silent about the instant method of "inhibiting the proliferation of vascular smooth muscle cells" in a subject, such claimed method must be inherently presented in the prior art method. Since the prior art method of administering the epoxide hydrolase inhibitor to graft patient or renal transplanted patient or atherosclerotic patient (page 2, para. 8 of the specification) would inherently possess the instantly claimed method. Therefore the reference anticipates the claimed invention.

11. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hammock et al. (WO 00/48593).

Hammock (WO 00/48593) teaches the administration of epoxide hydrolase inhibitor such as N,N'-dicyclohexyl urea (Table 1 and 4), to a subject for the treatment of inflammation (i.e., adult respiratory distress syndrome, systematic inflammatory response syndrome, cancer), wherein said epoxide hydrolase inhibitor is administered at a total daily dose from about 0.001 μM/kg to about 100mg/kg body weight of the mammal (claims 1, 10 and 12-15).

Although Hammock (WO 00/48593) is silent about the instant method of "inhibiting proliferation of vascular smooth muscle" in a subject, such claimed method must be inherently presented in the prior art method. Especially in light of the dosage amount disclosed in the instant application (page 15, lines 14-18), the prior art method of administering epoxide hydrolase inhibitor (i.e., N,N'dicyclohexyl urea) patients suffering from adult respiratory distress syndrome or systematic inflammatory response syndrome (but do not suffer from hypertension) which is associated with the decreased circulation to the heart would inherently possess the instantly claimed method when it is administered to said subject at the same dosage amount of

from about 0.001 μM/kg to about 100mg/kg body weight of the mammal as disclosed in the instant specification. Therefore the reference anticipates the claimed invention.

12. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Ingraham et al. (US 2003/0022929 A1).

Ingraham teaches the administration of epoxide hydrolase inhibitor represented by Formula I to a subject for the treatment of cardiovascular diseases including atherosclerosis, coronary artery disease, angina, ischemia, ischemic stroke and renal disease (column 2, para. [0006]; column 8, para. [0100]).

Although Ingraham is silent about the instant method of "inhibiting the proliferation of vascular smooth muscle cells" or "inhibiting proliferation of cells with inappropriate cell cycle regulation" in a subject, such claimed method must be inherently presented in the prior art method. Since the prior art method of administering the epoxide hydrolase inhibitor to patients having coronary artery disease, atherosclerosis, angina, ischemia, ischemic stroke or renal disease would inherently possess the instantly claimed method. Therefore the reference anticipates the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 11-17 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingraham et al. (US 2003/0022929 A1) in view of Selmon et al. (US 6120516).

The teaching of Ingraham has been discussed in above 102(e) rejection.

Selmon teaches the correlation of atherosclerosis and hypertension, coronary artery disease, angina or heart attacks. The reference discloses, as well-known scientific knowledge in the art, that atherosclerosis is major cause of coronary artery occlusions characterized by deposits of fatty substances, cholesterol, calcium and fibrin within the arterial wall, and the occlusion can manifest itself in hypertension, ischemia, angina, myocardial infarction, stroke or death; and the coronary artery occlusions is routinely treated by performing coronary artery bypass graft

surgery (CABG), percutaneous transluminal coronary angioplasty (PTCA), stents, atherectomy and transmyocardial laser revascularization (column 1, lines 21-34).

The teaching of Ingraham differs from the claimed invention in the administration of N-cyclohexyl-N'-dodecyl urea, specifically to a patient who has (had) a heart attack, coronary bypass, angioplasty, a stent in an arterial lumnen or a natural or synthetic vessel engrafted, wherein said CDU can be administered in combination with cis-epoxyeicosatrienoic acids. To incorporate such teaching into the teaching of Ingraham, would have been obvious in view of Selmon who teaches the correlation of atherosclerosis and hypertension, coronary artery disease, angina or heart attacks; and the atherosclerois as the major risk factor for the coronary artery occlusions; and the routine treatment options (e.g., CABG, percutaneous transluminal coronary angioplasty (PTCA), stents, atherectomy and tranmyocardial laser revascularization) available for the coronary artery occlusions in the art.

One having ordinary skill in the art would have expected that the administration of said soluble epoxide hydrolase inhibitors that has been known to be useful in the treatment of atherosclerosis, coronary artery disease, angina, ischemia and ischemic stroke would provide therapeutic utility in patient who has (had) a heart attack, coronary bypass, angioplasty, a stent in an arterial lumnen or a natural or synthetic vessel engrafted. One would have been motivated to combine these references and make the modification because they are drawn to same technical fields (constituted with same ingredients and share common utilities), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

With respect to claims 17, 21 and 25-26,

In addition to the above mentioned teaching of Ingraham, Ingraham teaches that EETs has similar activity as the soluble epoxide hydrolase inhibitors and enhancement of EETs concentration would have a beneficial therapeutic effect in patients where endothelial dysfunction plays a causative role (column 2, para. [0006]-[0008])

The above references in combination make clear that the soluble epoxide hydrolase inhibitor(s) and EETs have similar activity. It is obvious to combine two compositions each of which is taught by prior art to be useful for same purpose; idea of combining them flows logically from their having been individually taught in the prior art. The combination of active ingredient with the same character is merely the additive effect of each individual component.

11. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingraham et al. (US 2003/0022929 A1).

The teaching of Ingraham has been discussed in above 35 USC 102(e) rejection. In addition to the above mentioned teaching of Ingraham, Ingraham teaches derivatives of urea and carbamate inhibitors including CDU and DCU as known soluble epoxide hydrolase inhibitor (column 2, para. [0010]).

Although the teaching of Ingraham differs from the claimed invention in the use of CDU, such substitution would have been obvious to a person skilled in the art. One having ordinary skill in the art would have expected that CDU would have similar activity as the compounds of Formula I as soluble epoxide hydrolase inhibitor. One would have been motivated to make the modification because they are drawn to same technical fields (constituted with same ingredients

and share common utilities), and pertinent to the problem which applicant concerns about. MPEP 2141.01(a).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-5, 11-24 and 27 are rejected under the judicially created doctrine of double patenting over claims 1-2 of U. S. Patent No. 6693130 B2 or claims 1-9 of U.S. Patent No. 6531506, each further in view of Moser et al. (American Family Physician, Volume 56, Number 5, 1997).

Moser is being supplied as a reference to demonstrate the state of art knowledge in combination drug therapy in management of hypertension.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly required "inhibiting the proliferation of vascular smooth muscle cells" would have been inherently presented in the prior art method. Especially in light of the dosage amount disclosed in the instant application (page 15, lines 14-18), the prior art method of using epoxide hydrolase inhibitor (i.e., N,N'dicyclohexyl urea) for the treatment of hypertension

would inherently possess the instantly claimed method when it is administered to said subject at the same dosage amount of from about 0.001 μM/kg to about 100mg/kg body weight of the mammal as disclosed in the instant specification. Therefore the reference anticipates the claimed invention.

Although the instant claims limit the recipient of the claimed invention to a subject "(a) has had a heart attack, (b) has had a coronary bypass, (c) has been diagnosed with decreased circulation to the heart, (d) has undergone angioplasty, (e) has an endovascular stent, (f) has a hemodialysis graft, or (g) has a vascular graft", such determination of suitable treatment recipient group would have been obvious to the skilled artisan. For example, hypertension is the most important risk factor for heart attack, and many of patients suffering from heart attack or has had a heart attack are having hypertension.

Although the instant claims limit the recipient of the claimed invention to a subject "is being treated for hypertension by an agent that is not an inhibitor of sHE", such determination of suitable treatment recipient group would have been obvious to the skilled artisan. Since the management of hypertension often involves a combination therapy, one having ordinary skill in the art would have motivated to combine an inhibitor of sHE with other known antihypertensive agent such that the pharmacological activity of drug would be greatly increased while the adverse effects of the drug would be decreased by the reduction of the drug administered.

Response to Arguments

13. Applicant's arguments filed March 25, 2005 have been fully considered but they are not persuasive.

Applicant's argument in the response takes the position that the association between sHE inhibition and inhibiting cytokine production, which is the basis of Erickson's assertion for the treatment of the autoimmune diseases and disorders associated with T-lymphocyte mediated immune function including transplantation, allograft or xenograft rejection, and graft versus host disease listed in the application, has not proved out. Applicant alleges that the Erickson's study (Table 3) showing the activity of some sHE in reducing in IL-2 production whereas other sHE inhibitors do not reduce IL-2 production has not proved out that the patients with the claimed conditions would indeed benefit from the administration of sHE inhibitors.

This argument is found unpersuasive. Unlike the Applicant's argument, one having ordinary skill in the art would have known in light of Table 3 provided in the Erickson that the more potent compounds achieves the greatest efficacy in the cellular assays, and that inhibition of sHE would inhibit calcium influx into Jurkat cells, further inhibit IL-2 production (page 11, lines 13-22). Furthermore, as evidenced by Table 1, Table 2 and Figure, one having ordinary skill in the art would have understood that there is positive correlation between the inhibition of sHE and inhibition of cytokines (page 11, lines 4-11 and page 11, line 24 thru page 12, line 2). Since the instantly claimed inhibitor of soluble epoxide hydrolase refers to any compound having characteristic of soluble epxodie hydrolase inhibitor, the referenced teaching of administering soluble epoxide hydrolase inhibitors (i.e., N-[4-(5-ethyl-3-pyridin-3yl-pyrazol-1-yl)-phenyl]-nicotinamide, N-[4-(4-ethyl-3-pyridin-3-yl-pyrazol-1-yl)phenyl]-1-methylindole-2-carboxamide, 4-(3-cyanopropoxy)-N-[4-(4-cyano-3-pyridin-3-yl-pyrazol-1-yl)phenyl]benzamide, etc...) inherently possessing a therapeutic effect for the same ultimate purpose (i.e., transplantation, allograft xenograft rejection, graft versus host disease and disorder associated with T-lymphocyte

mediated immune responses such as arteriosclerosis, atherosclerosis, chronic and ischemic acute renal insufficiency) as disclosed by Applicant anticipates the Applicant's claims even absent explicit recitations of the mechanism of action. Anticipation under 35 USC 102 is an essentially irrebuttable question of fact, wherein the court stated that anticipation "cannot be overcome by evidence of unexpected results or teachings away in the art". *In re Malagari, 499 F.2d 1289, 182 USPQ; In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); In re Fracalossi, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); In re Alternpohl, 500 F.2d 1151, 183 USPQ 38 (CCPA 1974); In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973); In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).* Indeed, a reference might reside in a nonanalogous art and yet constitute an anticipation of a claimed invention under 35 USC 102. *In re Self, 571 F.2d 134, 213 USPQ 1 (CCPA 1982).*

Applicant's argument in the response takes the position that one having ordinary skill in the art would have not known that increasing EETs would provide beneficial effects in any of the conditions listed since more than a simple syllogism provided Ingraham would be necessary in anticipating the claimed invention. Applicant alleges that the etiology and causation of the diseases and disorders that is related to endothelial dysfunction stated in Ingraham is far more complex problem, which involves a balance of vasocontrictors and vasodilators, growth promoters and growth inhibitors, with nitric oxide and the rennin-angiotensin system being of particular importance.

This argument is found unpersuasive. Regardless of the alleged complexity nature of endothelial dysfunction, the prior art method of using the epoxide hydrolase inhibitors for the

same ultimate purpose (i.e., coronary artery disease, atherosclerosis, angina, ischemia, ischemic stroke or renal disease) would inherently possess the instantly claimed method when it is administered to the same treatment group at the overlapping dosage amounts as disclosed in the instant specification (see para. 103 of the Ingraham). Therefore, the reference anticipates the claimed invention.

Applicant's argument in the response takes the position that there is no logical nexus between Selmon and the contention that it would motivate one of skill to use sHE inhibitors to treat any of the conditions listed in the rejected claims.

This argument is found unpersuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one having ordinary skill in the art would have expected as taught by Ingraham that the administration of the soluble epoxide hydrolase inhibitor is useful in the treatment of atherosclerosis, coronary artery disease, angina, ischemia and ischemic stroke. Furthermore, one having ordinary skill in the art would have understood that there exist general art accepted correlation between atherosclerosis and hypertension, coronary artery disease, angina or heart attacks. Thus, one having ordinary skill in the art would expected that the administration of the soluble epoxide hydrolase inhibitor would provide therapeutic

utility in patient who has (had) a heart attack, coronary bypass, angioplasty, a stent in an arterial lumen or a natural or synthetic vessel engrafted.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Amendment to the claims to remove new matter as set forth in this Office Action, absent other amendatory language, may necessitate reinstatement of previously made rejection(s) over prior art under 35 USC 102 and/or 35 USC 103.

16. No Claim is allowed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (571) 272-0581. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached on (571) 272-0951. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Brian Kwon
Patent Examiner
AU 1614

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